

Appl. No. : 10/009,575
Filed : August 6, 2002

REMARKS

In response to the final Office Action mailed May 19, 2006, Applicant has amended the application as above. No new matter is added by the amendments as discussed below. Applicant respectfully requests the entry of the amendments and reconsideration of the application in view of the amendments and the remarks set forth below.

Discussion of Claim Amendments

Claims 19, 29-30 and 36 have been amended. Upon the entry of the amendments, Claims 19-36 are pending in this application. The amendments to the claims are to restore the original claims and do not introduce any new matter. Entry of the amendments is respectfully requested.

Amendments After Final Office Action

The amendments to the claims are to restore the original claims. Applicant respectfully submits that the previous claim amendments to include “the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing” were in fact unnecessary given that Ogilvie, having prior art status in pertinent part, does not teach the features of the original claims associated with “notifying” (will be discussed in greater detail later). Applicant also submits that the claim amendments were not presented earlier because Applicant realized after receiving this final Office Action that all of the cited portions that the Examiner relied on for claim rejections were not in fact prior art. Thus, Applicant respectfully submits that good and sufficient reasons why the amendments are necessary and were not earlier presented have been shown. *CFR § 1.116 (b) (3)*. Entry of the amendments is respectfully requested.

Discussion of Claim Rejections Under 35 U.S.C. § 112, ¶ 1

The Examiner has rejected Claims 19-36 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner states that the claimed feature of “the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing” is not described in the specification to enable one having ordinary skill in the art to make and use the invention.

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Applicant respectfully disagrees. However, in order to expedite the prosecution of the application and to reinstate the original claims, Applicant deleted the claim term.

Discussion of Claim Rejections Under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 19-36 under 35 U.S.C. § 103 (a) as being unpatentable over Olivier (U.S. Patent No. 6,480,885) and Ogilvie (U.S. Patent No. 6,324,569). Applicant respectfully traverses the Examiner's claim rejections as discussed below.

Standard of *Prima facie* Obviousness

In order to provide a *prima facie* showing of obviousness under 35 U.S.C. § 103(a), all the claim limitations must be taught or suggested by the prior art. *See, e.g., In re Royka*, 490 F. 2d 981, 180 U.S.P.Q. 580 (CCPA 1974); MPEP 2143.03.

Patentability of Independent Claims 19, 29-30 and 36

Each of Claims 19, 29-30 and 36 recites, among other things, "notifying the recipient if the message is unapproved." Applicant respectfully submits that neither Olivier nor Ogilvie, having prior art status in pertinent part, teaches or suggests the above-recited feature.

1. Olivier Neither Teaches Nor Suggests "Notifying the Recipient If the Message is Unapproved"

The Examiner asserts, citing column 13, lines 18-21 and 55-67, and column 15, lines 13-15 that Olivier teaches the above indicated feature of the claimed invention. *See this final Office Action at page 5*. Applicant respectfully disagrees. Applicant respectfully submits that none of the cited portions of Olivier teach "notifying the recipient if the message is unapproved." As Applicant repeatedly argued in the previous responses, Olivier at best teaches that if the message is not approved by the moderator, the sender is informed of that fact via email by the system. This means that the recipient is not notified about the unapproved message and thus is not given an opportunity to see the unapproved message. Furthermore, Applicant respectfully submits that

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if the Olivier system works for its intended purpose, the recipient must not receive the unapproved message and is not notified about the unapproved message.

In contrast, in the claimed invention, *the recipient is notified* about the unapproved message. One embodiment of the claimed invention has an advantage over Olivier in that the recipient is provided with the capability to manage unsolicited or unapproved e-mail messages without having the messages inadvertently removed by a message (or spam) filter (see the specification at page 20, lines 20-22). That is, the recipient, at his own discretion, can view an unapproved message or delete the message (see, for example, dependent Claims 20 and 26, Figure 2). In view of the above, Olivier neither teaches nor suggests the above-recited feature of the claimed invention.

2. Ogilvie Neither Teaches Nor Suggests “Notifying the Recipient If the Message is Unapproved”

Applicant respectfully submits that Ogilvie, having prior art status in pertinent part, neither teaches nor suggests the above-recited feature of the claimed invention. The Examiner asserted in the Office Action mailed January 4, 2005 (see the January 4 Office Action at page 4) that column 1, lines 55-64, column 13, lines 1-5 and column 14, lines 26-39 of Ogilvie teach “notifying the recipient if the message is unapproved.” However, upon review of the priority applications of the Ogilvie patent, Applicant respectfully submits that the above passages were not disclosed in either of the parent applications (Provisional Applications Nos. 60/104,138 and 60/101,517) of Ogilvie which antedate this application’s priority date of May 12, 1999. Furthermore, as argued in the previous responses, Applicant respectfully submits that column 2, lines 1-7; column 7, lines 4-22; and column 8, lines 2-11 of Ogilvie were not disclosed in the Provisional Applications Nos. 60/104,138 and 60/101,517.

In view of the above, Applicant respectfully submits that none of the passages of Ogilvie cited by the Examiner up until now with respect to the above-indicated feature of the claimed invention are prior art under 35 U.S.C. §§ 102 and 103. Thus, Applicant respectfully submits that Ogilvie neither teaches nor suggests “notifying the recipient if the message is unapproved.”

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In view of the above, independent Claims 19, 29-30 and 36 are allowable over the prior art of record.

Patentability of Dependent Claims

Claims 20-28 and 31-35 depend from base Claim 19 or 30, and further define additional technical features of the present invention. In view of the patentability of their base claims, and in further view of their additional technical features, Applicant respectfully submits that the dependent claims are patentable over the prior art of record.

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CONCLUSION

In view of Applicant's amendments and foregoing remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: _____

7/19/06

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